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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1712

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/763,084

Applicant(s)

BARA, ISABELLE

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 7/14/00; 4/6, 9/24, 9/27/01 & 9/16/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 26-88 is/are pending in the application.
- 4a) Of the above claim(s) 87 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 26-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 1 and 26-88 are pending. The PCT/DO/EO/905 form has been entered as Paper No. 2. The power of Attorney filed March 2, 2001 has been entered as Paper No. 3. The Declaration filed April 6, 2001 has been entered as Paper No. 4. The PCT/DO/EO/903 form has been entered as Paper No. 5. The priority papers have been entered as Paper No. 6. The Information Disclosure Statement filed April 6, 2001 has been entered as Paper No. 7. Claims 2-25 have been canceled and new claims 26-88 added by the preliminary amendment filed April 6, 2001, Paper No. 8. Claims 42 and 43 have been amended in the preliminary amendment filed September 24, 2001, Paper No. 9. Claims 42 and 43 have been amended in the preliminary amendment filed September 27, 2001, Paper No. 9. Applicants' election has been entered as Paper no. 12.

### ***Election/Restrictions***

1. Applicant's election with traverse of the invention of Group I, the gellan species in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the lack of unity practice requires unity to exist between the (1) method of manufacture, (2) the product and (3) the method of using said product. This is not found persuasive because the requirement set forth in PCT Rule 13.2 has not been met and therefore the groups cannot be concluded to have the same technical features.

Kaufman is direct evidence that the technical features do not define a contribution over the prior art. Whether a rejection is made over Kaufman at the time of the restriction is not the issue, although Kaufman is deemed to provide evidence that

PCT Rule 13.2 has not been met and the restriction is deemed proper. The prior art cited herein is further evidence that the claimed invention does not meet the minimum of being a contribution over the prior art in PCT Rule 13.2.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 87 and 88 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

#### ***Priority***

3. Receipt is acknowledged of papers received in this national stage application from the International Bureau (PCT Rule 17.2(a)), submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim interpretation***

4. several of the claims limit the species in a genus while not limiting the genus to said species. The remaining claim is generic to the remaining species. An example exist in claim 27, wherein the synthetic and semisynthetic gels of polyesters are limited but not defined as the hydrophilic gelling agent. The claims have been examined to the extent they read on the elected species.

The term solid and gel have been defined at page 6, lines 12-23. The particular gel strength is considered a physical property of gel compositions, which is often not characterized. It is noted the Office does not make experimental determinations. Attention is further directed to MPEP 2112.

Claims 85 and 86 recite an intended use without providing further structure for said recitation. The intended use recitation has been given little or no patentable weight.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 26-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Several of the claims contain improper alternative groupings that should be corrected. Attention is directed to MPEP 2173.05(h). An example may be found in claim 26 where the grouping does not use closed language and employs "and" several times. Said grouping is indefinite as to the scope of its members and the grouping. It is suggested applicants insert - - the group consisting of - - after chosen from and amend the groups to remove multiple use of "and".

Several of the claims employ the species as derivatives but fail to define how said materials are derived or what said derivatives consist. It is unclear what are the scope of the derivatives contemplated. See claim 26 wherein applicants set forth the limitations of "protein derivatives" and "derivatives thereof". It is further unclear what is the scope of a "derivative of" a "protein derivative". Other examples may be found in claim 31 and 33.

The limitation in claim 44 is unclear because "polydimethylsiloxane" is not conventionally considered a pigment. It is suggested applicants employ the language - - are coated with polydimethylsiloxane - -. Claim 45 has a similar issue.

In claims 46, 50 and 56; it is unclear the phase of claim 41 is required since the limitation "up to 40% by weight" reads on zero. At a minimum the claims may be construed to read on the respective pigments, nacreous substances and fillers in claims 46, 65 and 56 as optional when the other pulverulent materials are present. See also claim 77.

In claims 54 and 55, "the metallic soaps lacks antecedent basis.

Claim 84 is indefinite since a gel by definition has a continuous solid phase, eg., the hydrophilic polymer. It is unclear how the aqueous phase may make up the continuous phase.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 26-37, 39-68 and 83-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Rutter et al., US 5,731,191. Rutter et al (column 13, Table III) discloses growth mediums that are gels comprising gellan gum and polyethylene glycol (PEG) having a molecular weight of 4000. A molecular weight of 4000 for PEG equates to

about 90 units of oxyethylene. Rutter et al (Table I) discloses the gels have salts and vitamins and aminoacids in the compositions.

The gellan gum is employed at 2 g/l, which equates to about 0.2 % by weight of the composition. The PEG is employed at 0-100 g/l, which equates to about 0-10% by weight of the composition.

The disclosure of activated carbon reads on applicants' broad claim to pigments and fillers.

While the claims have been examined to the extent said claims read on the elected species, many of the claims define species of the hydrophilic gelling agent other than gellan gum but are generic to and read on the gellan gum as an alternative species. Examples of this are claims 27 and 29. A similar situation exist regarding the claims 41-58 for the pigments, nacreous substances and fillers. The activated carbon may function as a pigment since it is black in color and/or may likewise function as a filler. Claims drafted in this manner are rejected over the instant reference as anticipated since they read on the use of gellan gum and/or activated carbon.

Claim 65 is included herein since the growth medium (Table I) is a mineral water based on the numerous salts therein. The water concentrations overlap the ranges disclosed. Claim 66 read on mineral water.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1 and 26-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Intecos Italia SpA, EP 0 803 245 A, in view of Ha et al, US 5,997,887, Bara et al. et al., US 5,626,853, and Roulier et al, US 6,180,122.

Intecos Italia SpA examples discloses solid gels employing a polysaccharaide gelling agent and polyethylene glycol 200 and 400. Intecos Italia SpA (column 1, line 37 discloses as polysaccharides, the use of gellan.

Intecos Italia SpA differs from the claims in the molecular weight to the PEG (examples and column 1, lines 40-44).

Ha et al (column 29, lines 8-11) teaches a range of PEG-2, PEG-3, PEG-30 and PEG-50 as conditioning materials.

These references are combinable because they teach cosmetic compositions. It would have been obvious to one of ordinary skilled in the art at the time of applicants'

invention to employ the PEG compound of varied molecular weight as obvious functional equivalents shown to be conventional in the cosmetic art.

Bara et al (column 3, line 64 to column 4, line 7 and examples) discloses the use of polyethylene glycol 600 (PEG-12) in combination with other gelling agents in forming solid gels. Bara et al (column 12, line 2) further teaches the use of gellan as a gelling agent in said solid gels.

These references are combinable because they teach solid gel cosmetic compositions. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the gellan / PEG-12 combination as obvious functional equivalents shown to be conventional in the cosmetic art as evidenced by the Bara et al reference.

To the extent the claims further differ from the Intercos Italia SpA and Bara et al references, Roulier et al discloses conventional additives to solid cosmetic compositions including the use of gellan as the gelling agent and further cites (column 1, lines 41 et seq) EP 0 803 245 A.

Many of the claims may be rejected as reading on the genus when limitations to a single species are set forth in the alternative to the remaining species of the genus. Please see claim interpretation set forth above.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



**Daniel S. Metzmaier**  
**Primary Examiner**  
**Art Unit 1712**

DSM  
December 2, 2002